

REMARKS

I. Introduction

With the addition of new claims 19 to 21, claims 10 to 21 are pending in the present application. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority. However, the Office Action summary does not indicate whether the copy of the certified copy of the priority document has been received from the International Bureau. In this regard, the "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" indicates that the priority document was received by the United States Patent and Trademark Office. It is therefore believed that the copy of the certified copy of the priority application was received, and Applicant respectfully requests acknowledgment of receipt of the copy of the certified copy of the priority application in the next Office communication.

Applicant notes that an initialed copy of the PTO-1449 paper filed with an Information Disclosure Statement on September 20, 2000 has not been returned. Applicant respectfully requests consideration of the Information Disclosure Statement, PTO-1449 paper and cited reference and return of an initialed copy of the PTO-1449 paper with the next Office communication.

II. Amendment of the Abstract

The Office Action suggests replacement of "by means of" in the sixth line of the Abstract with --through the use of-. The Abstract has been amended as suggested. No new matter has been added.

III. Rejection of Claims 10 to 18 Under 35 U.S.C. § 112

Claims 10 to 18 were rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the Specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Office Action alleges that the use of the controller, claimed in claims 10 to 18, is unclear in the original disclosure, as there allegedly is no mention of what it controls or what it is used for. The Office Action further alleges that

the switching function is ambiguous, as the Specification is allegedly unclear as to what is being switched.

Applicant traverses this rejection and respectfully submits that the Specification makes clear what the controller is and what it is used for and what is being switched. For example, the Specification states that controllers are often used as “intelligent switch elements in industry, in science and in households” and that “switching sequences between input voltages applied to the signal inputs and the signal outputs can be programmed in a variety of ways.” Page 1, lines 7 to 10. Furthermore, Figure 1 illustrates a programmable controller having voltage inputs 2 (I) and voltage outputs 3 (O). The programmed controller is stated to switch the current flow between inputs 2 and outputs 3 under the control of a program. See page 3, lines 20 to 23.

Since the rejections under the first paragraph of 35 U.S.C. § 112 concern enablement, it is respectfully submitted that the standard for determining whether a patent application complies with the enablement requirement is that the specification describe how to make and use the invention -- which is defined by the claims. (*See* M.P.E.P. § 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable. (*See* M.P.E.P. § 2164.01 (citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (*See id.* (citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (*See id.* (citing *In re Wands*, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these

factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01). It is respectfully submitted that the Office Action has not addressed these factors.

Importantly, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See *id.* (citing *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (*See id.*).

It is believed that the present assertions of the Office Action do not meaningfully address -- as they must under the law -- whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation -- which it plainly does. In short, it is believed that the Office Action’s arguments and assertions do not really address the issue of whether one having ordinary skill would have to *unduly experiment* to practice the claimed subject matter of the rejected claims -- a proposition for which the Office bears the burden of proving a *prima facie* case as to the rejected claims.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of *Ex Parte Reese*, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner’s subjective belief that the specification was not enabling as to the claims. In particular, it is respectfully submitted that the subjective assertions of the Office Action are simply not supported by any real “evidence or sound scientific reasoning” -- which the law requires and which makes plain that the Office (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in *Ex parte Reese* was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation -- which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (*See id.*).

Moreover, the Board made clear that it is “incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence,” and also made clear that “[where an] examiner’s ‘Response to Argument’ is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph.” (*See id.* at 1222 & 1223; italics in original).

In the present case, it is respectfully submitted that the Office Action has not satisfied the foregoing for establishing that undue experimentation would be required. Indeed, the Office Action does not even allege that undue experimentation would be required to make and/or use the invention defined by the claims.

In view of all of the foregoing, it is respectfully requested that the enablement rejections of the claims under 35 U.S.C. § 112, first paragraph.

IV. Rejection of Claims 10 to 18 Under 35 U.S.C. § 102(e)

Claims 10 to 18 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,040,829. It is respectfully submitted that U.S. Patent No. 6,040,829 does not anticipate the present claims for the following reasons.

As an initial matter, the quoted section of 35 U.S.C. reproduced in the Office Action is inapplicable to the present application, and the statements that “[t]he changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b)” and that “this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA” plainly demonstrate that the present rejection is not based on a statute applicable to the present application. In this regard, 35 U.S.C. § 102(e) was amended pursuant to the “Intellectual Property and High Technology Technical Amendments Act of 2002,” Pub. L. 107-273, 16 Stat. 1901 (2002), and the amendments to 35 U.S.C. § 102(e) made thereby “apply to all patents and applications for patents pending on or filed after November 29, 2000.” Pub. L. 107-273 at § 4508. Accordingly, because the present rejection is based on a statute that was made inapplicable to the present application, withdrawal of this rejection is respectfully requested.

Notwithstanding the foregoing, it is respectfully submitted that U.S. Patent No. 6,040,829 does not constitute prior art against the present application and that this rejection should be withdrawn for this additional reason. In this regard, the present application entered

the national stage on September 20, 2000 based on International Application No. PCT/DE98/03780, filed on December 23, 1998, and claims priority to Application No. 198 12 423.6 ("the priority application"), filed in the Federal Republic of Germany on March 20, 1998. The claim to priority was made in the Declaration and Power of Attorney, submitted on September 20, 2000. A certified copy of the priority application was filed in the International Bureau, and a copy of the certified copy of the priority application was forwarded to United States Patent and Trademark Office, in its capacity as a Designated Office, which was acknowledged by the "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495," dated February 14, 2001. Enclosed herewith is a certified translation of the priority application.

U.S. Patent No. 6,040,829 issued on March 21, 2000 from U.S. Patent Application Serial No. 09/078,604, filed on May 13, 1998. Since the filing date of May 13, 1998 of U.S. Patent No. 6,040,829 is after the filing date of March 20, 1998 of the priority application, it is respectfully submitted that U.S. Patent No. 6,040,829 does not constitute prior art against the present application, and withdrawal of this rejection is therefore respectfully requested.

V. New Claims 19 to 21

New claims 19 to 21 have been added herein. It is respectfully submitted that new claims 19 to 21 do not add any new matter and are fully supported by the present application, including the Specification. It is respectfully submitted that these claims are allowable.

VI. Conclusion

Attached hereto is a marked-up version of the changes made to the Specification and the claims by the current Amendment. The attached page is captioned "Version with Markings to Show Changes Made."

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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Version with Markings to Show Changes Made

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IN THE SPECIFICATION:

The section captioned "Abstract" has been amended as follows:

A programmable controller has a processing unit, a display screen, an operator unit, and signal inputs and signal outputs. The processing unit, the display screen, the operator unit, the signal inputs, and signal outputs are accommodated in a common housing, and switching functions can be programmed by the user on the basis of predetermined functions by using a menu-assisted user interface on the display screen. A button of the operator unit can be switched to an active button [by means of] through the use of a programmable function, such that the sequence of a switching function depends on operation of this button.

IN THE CLAIMS:

New claims 19 to 21 have been added.